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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,751	10/01/2001	Emmanuelle Belli	13833.0008	3618

7590 10/22/2003

STEPTOE & JOHNSON LLP
1330 Connecticut Ave., N.W.
Washington, DC 20036

EXAMINER

HUI, SAN MING R

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 10/22/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/966,751

Applicant(s)

BELLI, EMMANUELLE

Examiner

San-ming Hui

Art Unit

1617

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 September 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.Claim(s) objected to: None.Claim(s) rejected: 26-48.Claim(s) withdrawn from consideration: None.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s).
10. ☐ Other: _____


SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER

10/17/03

Continuation of 5. does NOT place the application in condition for allowance because: Applicant's arguments averring the cited prior art failure to provide any motivation to prepare the herein claimed hydrophobic/hydrophilic graft copolymer have been considered, but are not found persuasive. Examiner notes that the instant case is not at all similar to that of *In re Baird*. There is no specific compounds taught in *In re Baird*; whereas the instant case, the specific monomers are taught in the cited prior art as the preferred monomers. As discussed in the previous action, Midha et al. clearly teaches the herein claimed monomers such as acrylic acid, methacrylic acid, acrilamide (see col. 6, line 63 to col. 7, line 47). Secondly, the number of species in *In re Baird* are 100 million compounds whereas the number of the species in the instant case are 6. Midha et al. also teaches the method of making graft polymers can be hydrophilic or hydrophobic backbone grafted with either hydrophilic or hydrophobic side chain (See col. 5, lines 15-25). Absent evidence to the contrary, one of ordinary in the art would have employ the monomers of Midha et al. to form the specific graft polymers herein and employing them into cosmetic hair composition as taught in Midha et al. since selecting the herein claimed hydrophilic/hydrophobic graft polymers would be simply considered as choosing from the obvious alternatives by one of ordinary skill in the art.

Applicant's also remarks that the size of the genus cannot be support an obviousness rejection. In response to the remarks, examiner notes that it is the size of the genus as the reason for both *In re Baird* and *In re Jones* that the court reverse the decision of the Board. Applicant's arguments averring the viscosity differences between non-cellulosic thickener and cellulosic thickener have been considered, but are not found persuasive. It is not clear why the differences in viscosity among different thickeners rendering the invention unobvious. As the matter of fact, it is well-expected that different thickeners will have different viscosity. Combining and employing various amount of the thickeners is reasonably expected to be useful in optimizing the viscosity of the final composition, absent evidence to the contrary. Applicant's arguments with regards to the recitation "consisting essentially of" have been considered, but are not found persuasive. When an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. According to the applicants, the basic and novel characteristics of the instant composition is disclosed. However, there is no evidence of record to show that the addition of various substances taught in the prior art would change such characteristics. Therefore, the rejection is still considered proper.

Applicant's arguments averring the cited prior art's failure to teach the motivation to incorporate guar gum. Absent evidence showing the criticality of using guar gum specifically, one of ordinary skill in the art would be considered substituting or incorporating guar gum into the composition of Midha obvious as being selecting from the obvious alternatives.